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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCADAMS, BRAD

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,944	<b>Applicant(s)</b> POIKSELKA ET AL.	
	<b>Examiner</b> ROBERT B. MCADAMS	<b>Art Unit</b> 2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20,32-41,43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,32-41,43 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/2010</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in response to the request for continued examination filed on March 22, 2010.
2. Claims 1-20, 32-41, 43 and 45 are pending.

### ***Response to Amendment***

3. Applicant's arguments with respect to Claims 1-20, 32-41, 43 and 45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 45** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is drawn to a "computer-readable memory medium". The specification is silent regarding the meaning of this term. Thus, applying the broadest reasonable interpretation in light of the specification and taking into account the meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art (MPEP 2111), the claim as a whole covers both transitory and non-transitory media. A transitory medium does not fall into any of the 4 categories of invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-20, 32-37, 40-41 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Denenberg* (U.S. Patent No. 6,859,649 B1) in view of *Coyne* (U.S. Patent No. 5,943,619).

7. As to **Claims 1-4 and 45**, *Denenberg* discloses detecting a change in said subscription information of said subscriber (**Changes in subscription information to different services are detected. Figures 5 and 6; Paragraph bridging Columns 7 and 8 and Column 4, Lines 35-42**);

checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information (**A terminal device subscribes to new services, the network element is determined to be eligible to receive the service, and if so, registering the subscriber to the network element. Figure 6; Paragraph bridging Columns 7 and 8, and Column 8, Lines 25-33**); and

initiating in response to the result of said checking step a registration procedure for registering said terminal device of said subscriber to a new serving network element

**(In response to checking capability, the terminal device is registered to the new network element. Figure 6; Column 8, Lines 25-33).**

However, *Denenberg* does not expressly disclose initiating a registration procedure for registering a terminal device if the changed subscription information is not in accordance with the capability of the network element.

*Coyne*, in the same field of endeavor, teaches registering a terminal device to a new network element, MSC/VLR, if the changed subscription information is not in accordance with the capability of the network element, MSC/HLR. **(Column 7, Lines 61-67 and Column 8 Lines 15-26).**

At the time of invention it would have been obvious to a person of ordinary skill in the art to have combined the subscriber registration method as taught by *Denenberg* with registering a terminal device to a new network element that supports subscription information as taught by *Coyne*. The motivation would have been to allow the terminal device to use additional subscription information features.

As to **Claims 5-7**, *Denenberg-Coyne* further teach wherein said checking step is performed on the basis of a capability information added based on said detection step to a response message of a re-registration procedure initiated by said terminal device **(*Denenburg*; In the event of subscriber information incompatibility, said terminal device is de-registered and given alternate capability information for re-registration during the activation periods. Column 5, Lines 23-42 and Column 8, Lines 19-24).**

As to **Claims 8 and 19-20**, *Denenberg-Coyne* further teach wherein a configuration information is provided for determining subscribed services needing predetermined serving network elements (***Denenburg; Administrative Center 280 provides configuration information for terminal devices and network elements, predetermining which network elements are subscribable. Figures 2-4; Column 6, Lines 41-54 and Column 5, Lines 43-62***).

As to **Claims 9-18**, *Denenberg-Coyne* further teach wherein said checking step comprises the steps of

transmitting a capability query comprising an information indicating at least one required capability to said serving network element (***The subscriber provides a required capability (home location)***),

comparing capabilities of said serving network element with said information about said at least one required capabilities (***The required capability is compared with eligibility database by the interrogator***), and

receiving an acknowledgment indicating the result of said comparing step from said serving network element (***An acknowledgment is received from the comparing step. If said elements are compatible then subscriber is passed through the proxy network element to be registered, else the subscriber is de-registered and given an alternative selection of compatible network elements for re-registration.***) (***Denenburg; Column 5, Lines 10-43***).

Apparatus **Claims 32-36** correspond to method **Claims 1-20** and are therefore analyzed and rejected the same as previously discussed with respect to **Claims 1-20**.

As to **Claim 37**, *Denenburg-Coyne* teach a processor receiving a de-register message containing a cause information, which indicates the reason for the de-register message, and in response to said de-register message, to initiate automatically a new initial registration procedure for registering said apparatus to a new serving network element providing session control services for said apparatus, if a result of a checking operation for checking a capability of a current serving network element indicates that the capability is not in accordance with a change in subscription information of said subscriber (***Denenburg*; The system receives a de-register message from the subscriber with the cause information suggesting incompatible subscription information. The system initiates a new registration procedure with an alternate billing plan if the checking operation determines the capability is not in accordance with the change in subscription. Column 5, Lines 23-42 and Column 8, Lines 19-24).**

As to **Claim 40**, *Denenburg-Coyne* teach an apparatus, comprising a processor configured to check whether a capability of a current serving network element serving a terminal device of a subscriber is still in accordance with a change in subscription information (***Denenburg*; The system determines wherein the network element is**

**determined to be eligible to receive the new service, and if so, registering the subscriber to the network element. Figure 6; Column 8, Lines 25-33).**

As to **Claim 41**, *Denenburg-Coyne* further teach sending a registration authorization message to a subscriber database in response to a registration message for a new registration of a terminal device (***Denenburg*; Step 615, Figure 6; Column 8, Lines 25-33**).

As to **Claim 42**, *Denenburg-Coyne* further teach a further processor configured to initiate a registration procedure for registering said apparatus to a new serving network element, based on the result of said processor (***Denenburg*; The system determines wherein the network element is determined to be eligible to receive the new service, and if so, registering the subscriber to the network element. Figure 6; Column 8, Lines 25-33**).

8. **Claims 38 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Denenberg* (U.S. Patent No. 6,859,649 B1) in view of *Coyne* (U.S. Patent No. 5,943,619) and in further view of *Wang* (U. S. PGPub No. 2002/0131395).

As to **Claims 38 and 39**, *Denenberg* discloses apparatus as previously discussed in Claim 37.



However, *Deneburg-Coyne* do not expressly disclose wherein said de-register message is a message in accordance with a session initiation protocol NOTIFY-message.

*Wang*, in the same field of endeavor, teaches sending messages over a session initiation protocol using NOTIFY-messages (**Paragraph 0038**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to have combined sending de-register messages in the apparatus, as taught by *Deneburg-Coyne*, to wherein said de-registration messages are in accordance with a session initiation protocol as taught by *Wang*. The motivation would have been to use a standard protocol for communication.

9. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Denenberg* (U.S. Patent No. 6,859,649 B1) in view of *Coyne* (U.S. Patent No. 5,943,619) and in further view of *Sanchez* (U.S. PGPub. No. 2002/0147845).

As to **Claim 43**, *Denenberg-Coyne* teach the apparatus as previously discussed in Claim 40.

However, *Denenberg-Coyne* do not expressly disclose the apparatus is an interrogating call state control function of an Internet Protocol Multimedia Subsystem.

*Sanchez*, in the same field of endeavor, describes using an interrogating call state control function of an Internet Protocol Multimedia Subsystem (**Paragraph 0009**).

At the time of invention, It would have been obvious to one of ordinary skill in the art to combine the apparatus as taught by *Denenburg-Coyne* with an interrogating call state control function as taught by *Sanchez*. The motivation would have been to use standard communication servers.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 5:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2456

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B. M./  
Examiner, Art Unit 2456

/Rupal D. Dharia/  
Supervisory Patent Examiner, Art  
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